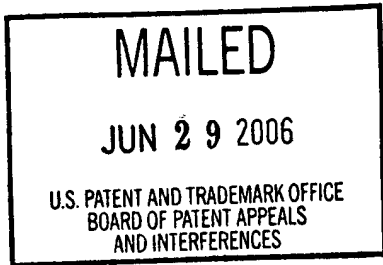


The opinion in support of the decision being entered today
was **not** written for publication in and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte CURTIS A. WHITCOMB

Appeal No. 2006-1187
Application No. 10/056,832

ON BRIEF

Before LEVY, NAPPI and FETTING, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1, 3 through 20, 22 through 39, 45 and 49 through 52. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a method of providing purchasers of vehicles with replicas portraying the vehicles they purchased. See page 1 of appellant's specification.

Claims 1 is representative of the invention and reproduced below:

1. A method of providing a purchaser of a product with a replica portraying the product including the steps of:
 - receiving product information relating to a visible feature of the product;
 - offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product; and
 - causing the replica including the visible feature to be transferred to the purchaser.

References

The references relied upon by the examiner are:

Hartman et al. (Hartman) 5,960,411 Sep. 28, 1999

Turkel, "Sweating the details Fernwood fo Maine's colorful, handcrafted replicas of buildings and scenes find a ready, robust market" *Portland Press Herald*, June 11, 2000. (Turkel)

The additional references we rely upon are:

Web site <http://web.archive.org/web/1991009212252/www.borton.com/parts.html>
(Borton Volvo) Dated September 15, 1999 (copy attached)

Rejections at Issue

Claims 1, 3 through 20, 22 through 32 and 49¹ through 52 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The examiner's rejection is set forth on pages 2 and 3 of the Final Office action mailed on April 27, 2005.

Claim 51 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The examiner's rejection is set forth on page 4 and Final Office action mailed April 27, 2005.

Claims 1, 4 through 7, 9, 10, 12, 14 and 15 stand rejected under 35 U.S.C. §102 (a) as being anticipated by Turkel. The examiner's rejection is set forth on pages 5, 6 and 7 of the Final Office action mailed April 27, 2005.

Claims 33 through 39 and 45 stand rejected under 35 U.S.C. § 102(b) as anticipated over officially noticed facts concerning two computers connected by the internet. The examiner's rejection is set forth on pages 8, 9 and 10 of the Final Office action mailed April 27, 2005.

Claims 33 through 39 and 45 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hartman. The examiner's rejection is set forth on pages 10 and 11 of the Final Office action mailed April 27 2005.

¹ We note the final rejection did not address the rejection of claim 49 under 35 U.S.C. § 101. However, since both the Brief (See page 8 footnote 1) and the Answer (see page 3) acknowledge claim 49 as rejected under 35 U.S.C. § 101 we will consider the rejection properly before us.

Claims 3, 8, 11, 13, 16 through 20, 22 through 32 and 49 through 52 stand rejected under 35 U.S.C. §103 as being unpatentable over Turkel. The examiner's rejection is set forth on pages 11 through 17 of the Final Office action mailed April 27, 2005.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellant and the examiner, and for the reasons stated *infra* we sustain the examiner's rejections of: a) claims 1, 3 through 7, 9 through 12, 14 through 20, 22, 24 through 32, 49 and 51 under 35 U.S.C. § 101; b) claims 1, 4 and 5 under 35 U.S.C. § 102 and c) claims 3, 8, 19, 23, 24, 27, 28, 31, 32 and 51 35 U.S.C. § 103. However, we will not sustain the examiner's rejections of: a) claims 8, 13, 23 and 52 under 35 U.S.C. § 101; b) claim 51 under 35 U.S.C. § 112 paragraph 1; c) claims 6, 7, 9, 10, 12, 14, 15 33 through 39 and 45 under 35 U.S.C. § 102; nor d) claims 11, 13, 16 through

18, 20, 22, 25, 29 and 30 under 35 U.S.C. § 103. Additionally, we enter a new ground of rejection against claim 33 under 35 U.S.C. § 102.

**Rejection of claims 1, 3 through 20, 22 through 32 and 49 through 52
under 35 U.S.C. 101**

Initially we note that appellant's arguments on pages 7 through 11 of the Brief, present separate arguments for four groups of claims. Accordingly, we will group the claims as argued by appellant. Group A consists of claims 1, 3 through 7, 9 through 12, 14 through 20, 22, 24 through 32, 49 and 51, with claim 1 as the representative claim. Group B, consists of claims 8 and 13, with claim 8 as the representative claim. Group C consists of claim 23 and Group D consists of claim 52.

Group A (rejection under 35 U.S.C. 101).

Appellant argues that the examiner, in applying a two part test of whether the invention is in the technological arts and whether the invention produces useful, concrete and tangible results, misapplied the law regarding 35 U.S.C. § 101. See brief pages 7 and 8. Appellant asserts that the proper test as set forth in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F3d 1368 (Fed. Cir. 1998) is whether the claimed invention is useful and produces concrete and tangible results. Appellant argues:

[T]he methods of each of independent claims 1 and 51 are useful in that they provide a service that many purchasers may find valuable. [Footnote omitted.] The claimed methods also produce concrete and tangible results as they result in the transfer of a replica of a purchased product to the purchaser.

Appellants further present arguments based upon *Ex parte Bowman*, 61 USPQ2d 119 (Bd. Pat. App. & Int. 2001).

The examiner's response, on pages 4 and 5 of the answer, rely heavily upon a finding that the claims are not within "the technological arts." Additionally, the examiner finds that the claims recite an abstract idea and preempt all uses of the abstract idea. The examiner states:

[A] look at the claims reveals that all of the recited steps are generic in nature and cover every possible way of performing the claimed steps. This is direct evidence that the claimed invention is directed to nothing more than an abstract idea.

While we concur with the examiner's determination that representative claim 1 is directed to non-statutory subject matter, we disagree with part of the examiner's analysis to support this conclusion. Specifically, as stated in our recent precedential decision in *Ex parte Lungren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under §101" *Lungren* at 76 USPQ2d 1388. Accordingly, we provide the following rationale to support our decision to affirm the examiner's rejection of claim 1 under 35 U.S.C. § 101 and as our rationale differs from that relied upon by the examiner we designate it as a new grounds of rejection pursuant to 37 CFR § 41.50(b).

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

35 U.S.C. § 101 defines four categories of inventions that Congress deems to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. § 100(b) (“The term ‘process’ means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”)

As seen, claim 1 on appeal is directed to a process because the claim sets forth a series of steps or acts to be preformed. Thus, one may wonder why there is any issue regarding whether claim 1 is directed to statutory subject matter. The issue arises because the Supreme Court has “. . . recognized limits to § 101 and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, physical phenomena and abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981).

While claim 1 appears to be a method claim, it is nonetheless directed to an abstraction and thereby falls within one of the Supreme Court’s exclusion from patent protection. In particular, claim 1 is drawn to a method of providing a purchaser of a product with a replica portraying the product (*i.e.* a method of selling a replica of a product). However, the steps of this method involve nothing more than exchanging information, making offers and the broadly

claimed, disembodied step of transferring the replica to the purchaser. We consider these to be abstract concepts. Claims directed to nothing more than abstract ideas, natural phenomena, and laws of nature are not eligible and therefore are excluded from patent protection. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 USPQ 193, 197 (1980); *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 67-68, 175 USPQ 673, 675 (1972); *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 76 USPQ 280, 281 (1948).

The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because “[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); *Parker v. Flook*, 437 U.S. 584, 590, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67, 175 USPQ at 675. Thus, “[w]hile a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.” *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9 (quoting *Mackay*, 306 U.S. at 94); see also *Corning v. Burden*, 56 U.S. (15 How.) 252, 268, 14 L.Ed. 683 (1853) (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”).

To satisfy § 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

- The claimed invention “transforms” an article or physical object to a different state or thing.
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

It is determined that claim 1 does not provides a transformation or reduction of an article to a different state or thing. The claim contains no step that alters a physical thing. The step of receiving product information does not involve a transformation rather only the abstract concept of exchanging information. The step of offering the purchaser an opportunity to purchase a replica does not involve a transformation, rather only the abstract concept of creating a legal offer to purchase an object. The final step of causing the replica to be transferred is broad and does not involve a physical transformation of the replica. Further, the limitation “transferred” broadly interpreted does not require physical transference and includes the transfer of ownership which is an abstract concept. Thus, the claim recites a series of abstract steps and does not transform or reduce an article to a different state or thing.

The inquiry into whether a claim fails the statutory requirement of 35 U.S.C. § 101, does not end because it is determined that the there is no

transformation or reduction of an article to a different thing or state. For eligibility analysis, physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358-59, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). Since the claim does not entail the transformation of an article, then it must be determined if the claim provides a practical application that produces a useful, tangible and concrete result. The Federal Circuit has said “The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to ...but on the essential characteristics of the subject matter, in particular its practical utility.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998). Further, the Federal Circuit explained that the claimed invention must produce a useful, concrete and tangible result, *State Street Bank*, 149 F.3d 1373, 47 USPQ2d, 1601 (see also *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

In this case, claim 1 is not drawn to a method that produces a tangible result. Appellant argues, on page 8 of the brief, that the claims “result in the transfer of a replica of a purchased product to the purchaser.” We disagree. As stated *supra*, we consider the claim 1 limitation of “causing the replica including the visible feature to be transferred to the purchaser” to be broad and

encompasses transferring ownership to a purchaser. We find that transferring ownership is an abstract concept and not a tangible concept.

Even when a claim applies an abstraction, as part of a seemingly patentable process, it must be determined that the claim does not in reality seek patent protection for the abstraction. *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). “Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *Gottschalk v. Benson*, 409 U.S. 63, 67, 175 USPQ 673, 675 (1972). One may not patent a process that comprises every “substantial practical application” of an abstract idea, because such a patent “in practical effect would be a patent on the [abstract idea] itself.” *Benson*, 409 U.S. at 71-72, 175 USPQ at 676; *cf. Diehr*, 450 U.S. at 187, 209 USPQ at 8 (stressing that the patent applicants in that case did “not seek to preempt the use of [an] equation,” but instead sought only to “foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process”). “To hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection.” *Diehr*, 450 U.S. at 192, 209 USPQ at 10.

In this case claim 1 preempts a § 101 judicial exception. Claim 1 is directed to a method of providing a purchaser of a product with a replica portraying the product (i.e. a method of selling a replica of a product). Musical

compositions, works of literature or works of art are nothing more than abstract ideas. Claim 1 does not include a limitation directed to any one application of the method of selling a replica of a product; rather the claim only recites providing the purchaser of a product with a replica of a product by a specific merchant. Claim 1 recites steps that encompass a variety of forms of making offers to the purchaser and transferring the replica to the purchaser. Additionally, the claimed steps encompass many ways to communicate the selling of a replica of a product to the purchaser. The steps of receiving product information and offering it to the purchaser do not specify any specific forum or form of communications used to convey the information and offer. The step of causing the replica to be transferred to the purchaser is not limited to any manner of transferring the replica to the purchaser, i.e. the claim does not recite whether the transference of the replica is the legal transference or physical transference. Thus, the claim encompasses all ways of selling a replica of a product to a user by a product merchant and thereby, the claim covers every substantial practical application thereof. Therefore, the claim preempts any and all uses of the abstraction. Accordingly, we sustain the examiner's rejection of representative claim 1 and the claims grouped with claim 1 in group A (claims 3 through 7, 9 through 12, 14 through 20, 22, 24 through 32, 49 and 52).

Additionally, we are not persuaded by appellant's arguments relying upon *Ex parte Bowman* 61 USPQ2d 1669. *Ex parte Bowman* is not a precedential decision and is not binding on the Board.

Group B (rejection under 35 U.S.C. 101).

Appellant states that each of claims 8 and 13 recites two computing devices connected by a network as well as the transfer of information from one computing device to another over the network. As such, appellant argues that claims 8 and 13 recite more than just an abstract idea. Further, appellant argues that the examiner's rationalization that these limitations do not recite a meaningful use of technology is improper. See brief pages 9 and 10.

In response the examiner asserts relies upon the physical transformation test to determine that the claims are not directed to statutory subject matter.

We disagree with the examiner's reasoning. As stated *supra*, the physical transformation test of *Dimond v. Diehr* is one of the many tests that can be used to determine if a claimed invention is directed to statutory subject matter. However, it is not determinative as to whether the claim is directed to non-statutory subject matter. In this case dependent claim 8 recites limitations directed to method including a registrar computing device and a merchant computing device and a network. These computing devices receive information over the network. Claim 13 contains similar limitations. Clearly, these claims are directed to a method performed on a machine, as such, the claims are not drawn to an abstraction and do not fall within one of the aforementioned § 101 judicial exceptions. Accordingly, we will not sustain the examiner's rejection of claims 8 and 13 under 35 U.S.C. § 101.

Group C (rejection under 35 U.S.C. 101).

Appellant asserts, on page 10 of the brief, that claim 23 recites “wherein the registrar includes a registrar computing device having a database” and that as such claim 23 is directed to statutory subject matter.

The examiner’s response to this argument is the same as discussed above with respect to claims 8 and 13 and we similarly disagree with the examiner’s rationale. Claim 23 recites a registrar computing device, clearly claim 23 is drawn to a method performed on a machine. As such, the claim is not drawn to an abstraction and does not fall within one of the aforementioned § 101 judicial exceptions. Accordingly, we will not sustain the examiner’s rejection of claim 23 under 35 U.S.C. § 101.

Group D (rejection under 35 U.S.C. 101).

Appellant argues on pages 10 and 11 of the brief that claim 52 recites the step of “communicating the product information and the owner information to a replica manufacturer using a computing device” and as such is drawn to statutory subject matter.

The examiner’s response to this argument, on page 7 of the answer, is the same as discussed above with respect to claims 8 and 13 and we similarly disagree with the examiner’s rationale. Claim 52 recites a using a computing device to communicate product information, thus claim 52 is drawn to a method performed on a machine. Further, claim 52, also recites the limitation of

“causing the creation of a certificate of ownership associating the owner with the replica” and “causing the creation of a replica” both of which are steps that result in the physical transformation of an item. As such, the claim is not drawn to an abstraction and does not fall within one of the aforementioned § 101 judicial exceptions. Accordingly, we will not sustain the examiner’s rejection of claim 52 under 35 U.S.C. § 101.

Rejection of claim 51 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Appellant argues, on pages 11 and 12 of the brief, that the step of “offering to the purchaser at the time of the sale of the product an opportunity to receive a replica of the product” is supported by several passages in the specification. Specifically, appellant points to figures 2, 4 and the passages on page 3, lines 22 through 30 and page 7, lines 13 through 16.

The examiner states, on page 8 of the answer, that the limitation is not inherent to the disclosure in the appellant’s specification. Further, the examiner states:

The citation describing figure 4 at best indicates that the offering is made after the product is purchased and does not support the making of the offer at the time of purchase. Step 410 is the purchasing of the product. Step 420 is offering the purchaser an opportunity to buy a replica that portrays the purchased (past tense) product 4. If you are offering a replica for purchase at the same time as purchasing the product, how can the product be referred to as being “purchased”, which is past tense?

We disagree with the examiner’s rationale. We note that appellant’s specification, on page 3, line 29 through page 4, line 2, states:

Merchant 14 may provide purchasers 10 or owners 12 with a replica 6 in the normal course of business (omitting step 220). In such a scenario, the price of the product 4 essentially includes the price of the replica 6, thus giving purchasers 10 the impression that the replica is a gift.

Claim 51 includes the limitation “offering the purchaser at the time of the sale of the product an opportunity to receive a replica of the product.” We find that the above noted passage from the appellant’s specification clearly teaches that the replica can be given (presented) to the purchaser at the time of purchase, as the price of the replica is included in the price of the product. Accordingly, we will not sustain the examiner’s rejection of claim 51 under 35 U.S.C. §112, first paragraph.

Rejection of claims 1, 4 through 7, 9, 10, 12, 14 and 15 under 35 U.S.C. §102 (a) as being anticipated by Turkel²

Initially we note that appellant, on pages 13 through 15 of the brief, presents separate arguments for six (6) groups of claims. However, appellant’s only argument directed to the group of claims 5, 9, and 10, states “claims 5, 9, and 10 depend (either directly or indirectly) from claim 1, and are believed allowable for at least the reasons set forth above with regard to claim 1.” We do not consider this to be a separate argument under 37 C.F.R 41.37(c)(vii). Accordingly, we will group the claims into five (5) groups. Group A consists of

² Appellant and Examiner refer to the article authored by Tux Turkel, titled “Sweating the details Fernwood fo Maine’s colorful, handcrafted replicas of buildings and scenes find a ready robust market” by the title “Fernwood.”

claims 1, 4 and 5 with claim 1 as the representative claim. Group B, consists of claim 6 with claim 6 as the representative claim. Group C consists of claim 7 and Group D consists of claims 8, 9, 10 and 12. Group E consists of claim 14 and 15.

Group A (rejection under 35 U.S.C. 102).

Appellant states that claim 1 recites the step of “offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product.” Appellant argues:

Nothing in the Fernwood article teaches, expressly or inherently, that the bank offered the home buyer an opportunity to purchase a replica of the home. If anything, the Fernwood article seems to indicate that the bank simply asked Fernwood to paint replicas on it's own accord, and provided those replicas as surprise gifts to the home owners. [Brief, page 13.]

In response, the examiner states that Turkel does teach offering a replica to the purchaser as claimed because “the claimed term ‘purchase’ is defined in the instant specification on page 2 as generally meaning ‘an exchange of value’ and includes the act of bestowing a product.” See Answer, page 9. [Emphasis omitted.]

We concur with the examiner's claim interpretation and findings regarding the teachings of Turkel. Claim 1 includes the limitation of “offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product.” The examiner in the statement of the rejection equates the claimed merchant with the bank in

Turkel. See Final Office action mailed August 11, 2005. Appellant has not challenged this finding by the examiner and we find that the examiner's equating of the bank with the merchant of the product is proper as banks often sell property (e.g. foreclosure sales). Further, the examiner has interpreted the term "purchase" to include the act of receiving something bestowed. We find that appellant's specification supports this claim interpretation. Appellant's specification, in the paragraph bridging pages 2 and 3 states:

The terms "purchase," "purchases," "purchased" and "purchasing" are used herein to generally mean "an exchange for value" and includes the concepts of buying, leasing, bartering and/or bestowing. In the case of a bestowed product, it should be appreciated that there is still an exchange of value because the person bestowing product 4 receives good will in return for the bestowed product.

Thus, appellant's arguments have not convinced us of error in the examiner's rejection of claim 1. Accordingly, we sustain the examiner's rejection of claim 1 and the claims grouped therewith, claims 4 and 5.

Group B (rejection under 35 U.S.C. 102).

Appellant states that claim 6 recites the registrar obtaining information to the owner of the product to associate the product and the replica with the owner. See brief pages 13 and 14. Appellant asserts that the examiner's determination that the information of what the replica is to look like, is information related to an owner of the product is flawed. Appellant reasons that the examiner's determination is flawed because it concludes that product information and owner

information are the same thing. Further, appellant argues that Turkel does not teach a registrar or that the information received associates the product and replica with the owner. See brief page 14.

In response the examiner states, on last paragraph of page 9 through page 10 of the answer:

The limitation of "information related to an owner of a product" is very broad language and the examiner sees no reason why the style of home cannot be considered as information that is related to an owner of a product. If an owner owns a particular style of home, the information about the home style is related to the owner because the owner owns a house of that style.

We disagree with the examiner's rationale. Dependent claim 6, because of its dependency, includes the limitations of claims 1 and 5. Claim 6 recites, "a registrar receives the product information" and "the registrar also obtains information relating to an owner of the product to associate the product and the replica with the owner." In the context of the claim the "information relating to an owner" associates the product and the replica to the owner, which is different than the "product information relating to a visible feature of the product." Thus, while information relating to the style of the house may be product information as it relates to a visible feature, we do not find that it associates the product and replica to the owner as claimed. Accordingly, we will not sustain the examiner's rejection of claim 6.

Groups C, D and E (rejection under 35 U.S.C. 102).

Appellant states that claim 7 recites the step of “providing a registrar for receiving the product information from the merchant, the registrar using the product information and information relating to an owner of the product to associate the product and the replica with the owner.” Appellant argues that the examiner’s rationale equating the registrar with an employee, such as a sales representative who is responsible for sales of replicas, is flawed. Turkel does not disclose such a person who equates the orders with the owners.

In response, on page 10 of the answer, the examiner states that:

[W]hen a sales representative (the registrar) takes an order, such as from the bank, they are inherently associating the owner with the product based on the order itself. It is not reasonable to take a position that the sales representative of Fernwood will not be associating (very broad term) the owner and the replica to each other.

We disagree with the examiner’s rationale. Initially, we note that Turkel’s article (referred to as Fernwood by the examiner) makes no mention of a sales representative. Further, the examiner has not presented convincing evidence that such a representative would associate the replica with the owner of the product (in Turkel’s article the owner would be the home owner). The examiner’s statement that making such an association is inherent is not well taken.

Inherency is not established by possibilities or probabilities. In Turkel’s article it appears that the replicas of houses are ordered by the bank and delivered to the bank that then gives the replica to the purchaser of the house. Thus, there is no

disclosure of the owner and the replica manufacturer having a contact, nor would it seem that the replica manufacturer would need to know to whom the bank is giving the replica. Thus, we do not find that Turkel, either expressly or through the principals of inherency teaches the limitations of claim 7 and we will not sustain the examiner's rejection of claim 7 under 35 U.S.C. §102. Claims 9, 10, 12, 14 and 15 all depend directly or indirectly upon claim 7. Thus, we will not sustain the examiner's rejection of claims 9, 10, 12, 14 and 15 under 35 U.S.C. §102 for the reasons stated *supra* with respect to claim 7.

Rejection of claims 33 through 39 and 45 under 35 U.S.C. § 102(b) as anticipated over Officially Noticed facts concerning two computers connected by the Internet.

Appellant argues that the "wherein" clause of claim 33 is ignored by the examiner as the examiner improperly considered it to be a statement of intended use. See brief page 16. Appellant asserts that claim 33's limitation "wherein the merchant computing device is configured to receive product information relating to a visible feature of a product purchased by the purchaser, the received product information being transferred as a replica order over the network to a replica manufacturer computing device, thereby enabling a replica including the visible feature of the product to be transferred to the purchaser" is a functional limitation. Appellant argues that the examiner has presented no evidence that "the functional limitation of transferring information relating to a visible feature of a product as a replica order to a replica manufacturer computing device to

enable a replica to be transferred to the product purchaser necessarily flows from the existence of the Internet.” [Brief, page 17, emphasis original.]

The examiner responds stating that a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. In this case the examiner has found that the prior art is structurally the same as the claimed invention and is capable of doing what is performed. See answer, page 11.

We concur with the appellant. Claim 33 recites “wherein the merchant computing device is configured to receive product information relating to a visible feature of a product purchased by the purchaser, the received product information being transferred as a replica order over the network to the replica manufacturer computer device, thereby enabling a replica including the visible feature of the product to be transferred to the purchaser.” The claim recites the information relating to a visible feature of the product is received, then transferred to a replica order and enables the transference of the replica to the user. Thus, we find the information functionally relates to the step of transferring the appropriate replica to the owner and we find the wherein limitation functionally limits claim 33. As the examiner has presented no evidence that such features were known at the time of the invention, we will not sustain the examiner’s rejection of claims 33 through 39 and 45 under 35 U.S.C. § 102(b) as anticipated over officially noticed facts concerning two computers connected by the Internet.

Claims 33 through 39 and 45 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hartman.

With regard to this rejection appellant presents the same arguments as discussed above with respect to the examiner's rejection based upon official notice. The examiner provides the same arguments in response. The examiner has not shown nor do we find that Hartman teaches a computer which receives information relating to a visible feature of the product and then transfers a replica order to another computer which enables the transference of the replica to the user as is claimed in independent claim 33. Accordingly, we will not sustain the examiner's rejection of claims 33 through 39 and 45.

Rejection of claims 3, 8, 11, 13 16 through 20, 22 through 32 and 49 through 52 under 35 U.S.C. §103 as being unpatentable over Turkel.

Claims 3, 8, 19, 23, 24, 27, 28, 31 and 32.

On page 19 of the brief, appellant argues that claims 3, 8, 19, 23, 24, 27, 28, 31 and 32 are all dependent upon claim 1 and should be allowable for the reasons argued with respect to claim 1. As stated *supra*, we are not persuaded by appellant's arguments directed to claim 1 and sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102. Accordingly, we also sustain the examiner's rejection of claim 3, 8, 19, 23, 24, 27, 28, 31 and 32 under 35 U.S.C. §103.

Claims 11, 13, 16 through 18, 20, 22, 25, 29 and 30.

We note that claims 11, 13, 16 through 18, 20, 22, 25, 29 and 30 are all ultimately dependent upon claim 7, as stated *supra* we do not find that Turkel

teaches the limitations of claim 7, nor do we find that Turkel provides suggestions which makes claim 7 obvious. Thus, for the reasons recited *supra* with respect to claim 7 we will not sustain the examiner's rejection of claims 11, 13, 16 through 18, 20, 22, 25, 29 and 30 under 35 U.S.C. § 103.

Claims 49 and 52.

Appellant provides separate arguments for claims 49 and 52, however as they deal with the same issue we will treat them together.

Appellant asserts, on page 22 of the brief, that claim 49 recites a certificate of ownership, which "associates the replica with the owner." Appellant asserts, on page 20 of the brief, that claim 52 recites, "causing the creation of a certificate of ownership associating the owner with the replica." Appellant, on page 20 of the brief, argues:

Nothing in the Fernwood article (or any of the other cited art) teaches, suggests, or even hints at the creation or transfer of a certificate of ownership as claimed. The Examiner contends that a receipt of sale of a replica would be obvious in view of the Fernwood article. (the Final Action, pg. 14). A receipt, however, is not a certificate of ownership that associates the owner with the replica.

In response, the examiner states, on page 13 of the answer:

[A] receipt is a proof of purchase and does indicate ownership. A person holding a receipt to an article has proof of its sale and is an indication of ownership. Because receipts are given to the purchaser, a person with no receipt would not be considered as the owner.

We disagree with the examiner's rationale. Initially, we note that we concur with the examiner's assessment that a receipt is a proof of purchase and

can be an indication of ownership, but we disagree that a person with no receipt would not be considered an owner. A receipt is a document showing that payment has been received; oftentimes when gifts are made a receipt is not given with the gift, yet the recipient of the gift is the owner. In the teaching of Turkel, it appears that the bank is giving the replica to the homeowner as a gift, thus we do not find that Turkel necessarily requires a receipt be given to the home purchaser. Further, in the context of the claim, the owner is the owner of the product (this would be the home buyer in Turkel) as such the certificate of ownership associates the owner of the product with the replica. A receipt for purchasing a replica would associate the purchaser of the replica with the replica, not the owner of the product the replica represents with the replica. Accordingly, we will not sustain the examiner's rejection of either claim 49 or claim 52.

Claim 51.

Appellant asserts, on page 24 of the brief, that claim 51 recites the step of "offering the purchaser at the time of the sale of the product an opportunity to receive a replica of the product." Appellant argues that Turkel suggests "the bank purchases the replicas after the houses were sold and that the bank made no offer to the buyers at all, but later gives the replicas as gifts."

In response the examiner states, on page 17 of the Final rejection mailed April 27, 2005:

For claim 51, not disclosed is that the offer for the replica is made at the same time as the sale of the product. In Fernwood this would be the situation of offering the replica to the home owner at the closing of the home, which is the point of time when legal documents are signed and the sale occurs. The examiner feels it is common sense and would be obvious to one of ordinary skill in art at the time the invention was made to ask the new home owner at closing if they would like to receive a free gift of a replica of their newly purchased home or to tell them that one should be expected in the mail. Also in addition to the above obviousness statement the examiner considers the timing of the offer for the replica to be one of sales style because the timing of the offer has no material affect on the end result of the invention. The offer could be made just before a person signs the bank loan documents for the sale of the home, or could be made just after the signing of the papers, it does not matter in the end.

We concur with the examiner. We find that Turkel teaches that the bank orders and gives recent home buyers replicas of their newly purchased homes. The passage of Turkel cited by the examiner implies that these replicas would not be physically transferred to the owner until after the sale of the house (as the article refers to newly purchased homes). Further, it stands to reason that that purchaser (home buyer) would be notified of the gift at some time, either, before the sale, during the sale or after the sale. It is not clear from Turkel when the bank notified the purchaser of the gift, clearly the purchaser is notified upon receipt of the gift, which would be after the sale of the property. The examiner provides a rational and cogent explanation of why it would be obvious to communicate that a gift will be transferred to the purchaser (home buyer) during the sale of the property, as all of the parties will be present at the closing (the time of the sale of the product). Thus, we concur with the examiner's

determination that it is obvious that the bank in Turkel would have notified the purchaser of a house that the bank would be providing a gift of a replica of their new house.

Appellant's further argument that the examiner's discussion of the timing of the offer having no material effect on the end result of the claimed invention, has not persuaded us of error in the examiner's rejection. While the examiner's comments in the statement of the rejection to this effect may have been misplaced. As discussed *supra*, the examiner did nonetheless make a finding that such timing would be an obvious modification of Turkel.

New Grounds of rejection pursuant to 37 CFR § 41.50(b)

We apply new grounds of rejection against representative independent claim 33. We leave it to the examiner to consider whether similar rejections apply to the other claims in the application.

Claim 33 recites a "merchant computing device" and a "replica manufacturer computing device", we construe terms "merchant" and "replica manufacturer" to be titles associated with the computing device and do not find that the claim recites any functionality to the computing device. The Borton Volvo Web site teaches a document that is on a computer (equated to the claimed replica manufacturer computing device) that can be accessed by a customer's (the claimed merchant computing device) computer via the network the Internet. Claim 33 also recites the merchant computing device receiving

product information relating to a visual feature of the product. The claim does not recite the source of the information. The Web page, which when loaded on the customer's computer contains information representing a visual representation of a product, see photograph of metal model of Volvo 855 (replica of Volvo car) on page 3 of the attached print out. The web site also enables customer, through the customer's computer to place an order for the replica over the Internet, see page 6 which shows a link to an order form. The replica is then transferred via a shipping carrier to the customer. Thus, we find that the Borton Volvo Web site anticipates the limitations of claim 33.

Conclusion

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

We sustain the examiner's rejections of: a) claims 1, 3 through 7, 9 through 12, 14 through 20, 22, 24 through 32, 49 and 51 under 35 U.S.C. § 101; b) claims 1, 4 and 5 under 35 U.S.C. § 102 and c) claims 3, 8, 19, 23, 24, 27, 28, 31, 32 and 51 35 U.S.C. § 103. However we will not sustain the examiner's rejections of: a) claims 8, 13, 23 and 52 under 35 U.S.C. § 101; b) claim 51 under 35 U.S.C. § 112 paragraph 1; c) claims 6, 7, 9, 10, 12, 14, 15 33 through 39 and 45 under 35 U.S.C. § 102; nor d) claims 11, 13, 16 through 18, 20, 22, 25, 29 and 30 under 35 U.S.C. § 103. Additionally, we enter a new ground of rejection against claim 33 under 35 U.S.C. § 102

Appeal No. 2006-1187
Application No. 10/056,832

No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART; 37 CFR § 41.50(b)


STUART S. LEVY
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge


ANTON W. FETTING
Administrative Patent Judge

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REN/vsh

Appeal No. 2006-1187
Application No. 10/056,832

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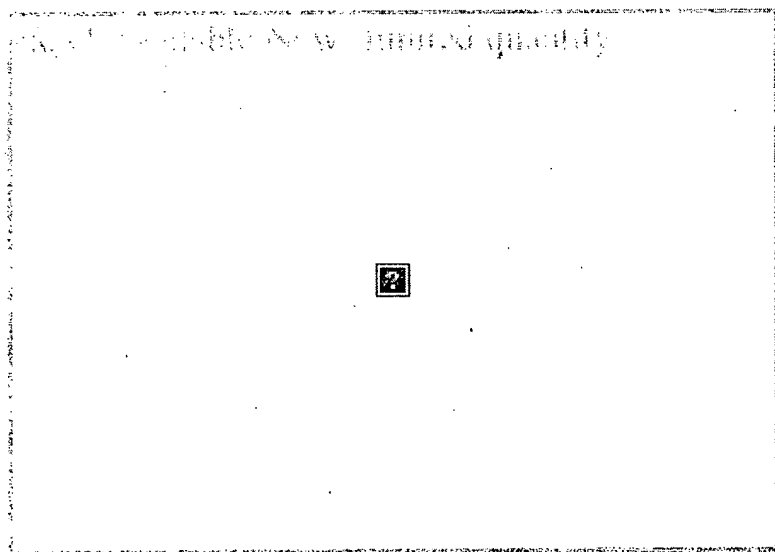


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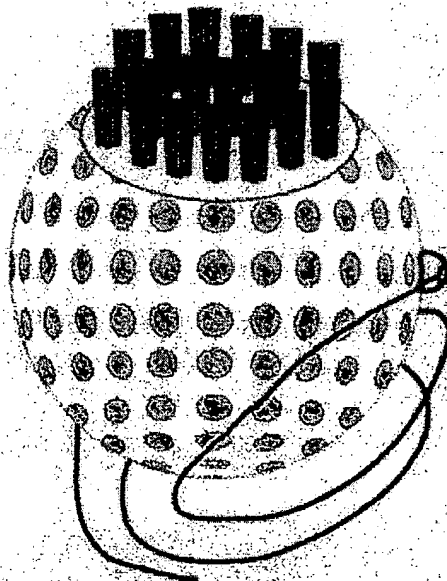
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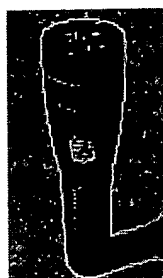


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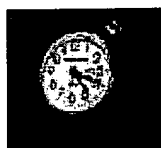
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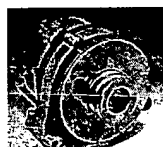
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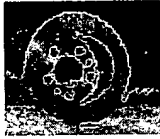
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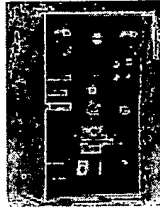
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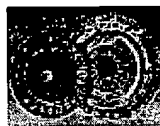
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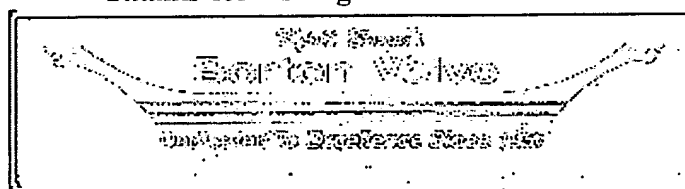


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